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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,814	12/12/2003	Gary Santoro	16092	2794

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EXAMINER

CLARKE, SARA SACHIE

ART UNIT PAPER NUMBER

3749

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/734,814	Applicant(s) SANTORO, GARY	
	Examiner Sara Clarke	Art Unit 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by Gerassi (U.S. Pub. No. 2003/0211049).

Gerassi discloses the invention as claimed including a cigarette lighter device 20 having a lighting mechanism 24, a housing member 22, and an external side surface (the bottom side of the reservoir 22); and a breath freshening dispenser 40 attached to said side surface for holding a plurality of edible breath fresheners.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Doo-Seok (US 5364263).

Doo-Seok discloses the invention as claimed including a cigarette lighter device 10 having a lighting mechanism 1, a housing member 7, and an external side surface; and a breath freshening dispenser 28 attached to said side surface for holding a plurality of edible breath fresheners. Fig. 6 shows the external side surface including a

pair of mounted parallel tracks 31 for attaching the breath freshening dispenser 28 to the cigarette lighter device.

Regarding the claim limitation of the dispenser being used for edible breath fresheners, see MPEP 2131.05.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Whittaker (US 2071601).

Whittaker discloses the invention as claimed including a cigarette lighter device having a lighting mechanism 20, a housing member 1, and an external side surface (including back wall 2); and a breath freshening dispenser attached to said side surface for holding a plurality of edible breath fresheners. The breath freshening dispenser includes a hinged cover 6 for easily accessing the edible breath fresheners therein.

Regarding the claim limitation of the dispenser being used for edible breath fresheners, see MPEP 2131.05.

Response to Arguments

With respect to the Gerassi reference, applicant argues "[t]he phrase "external side surface", as it is employed in claim 1, cannot be read to encompass the bottom surface of the lighter 20 of Gerassi without ignoring or greatly distorting the specification of the pending application." Applicant also argues that this same argument applies to the Doo-Seok and Whittaker references.

The examiner disagrees.

During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to

achieve a complete exploration of the applicant's invention and its relation to the prior art. In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), citing In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

The applicant provides no clear definition of "external side surface" in his original specification. Thus, the term "external side surface" is given its plain meaning. The bottom of the lighter of Gerassi is a "side" of the lighter in that it is the bottom side of the lighter.

Applicant's arguments have been considered with regard to Gerassi, Doo-Seok, and Whittaker. However, since they merely attempt to read the specification into the claims and are not supported by the specification as filed, they are not found convincing.

With regard to the Doo-Seok reference, applicant argues on pages 5 and 6 as follows:

Doo-seok provides a gas lighter body 10 with an L-shaped recess 5 into which a housing 28 containing a disposable razor blade assembly can be inserted. The housing 28 is therefore a constituent part of a side surface of the lighter body 10. Given that a first element cannot be both a constituent part of a larger second element and also be attached to the second element, and the previous discussion of the phrase "external side surface" recited in claim 1, Doo-seok does not anticipate the combination cigarette lighter and breath freshening dispenser of claim 1.

The examiner disagrees.

How the applicant makes the leap from the shape of the lighter body of Doo-seok (i.e., that it has an L-shaped recess into which housing 28 is inserted) to the conclusion that the housing is somehow a constituent part of the side surface of the lighter is unclear. What is clear is that the lighter of Doo-seok is capable of operating as a lighter

without the housing 28 attached to it. Thus, housing 28 is not a "constituent" part of the lighter or its side surface.

Applicant's arguments have been considered. However, since applicant's conclusion that the housing is a constituent part of the lighter is not found convincing, the rejection is considered to have been properly made.

Likewise, applicant argues that the Whittaker reference also does not disclose the invention because the main compartment, covered by lid 6, is a constituent part of the casing 1. Likewise, the lighter of Whittaker is capable of operating as a lighter without the hinged lid. Thus, the hinged lid is not a "constituent" part of the lighter or its side surface.

Applicant's arguments have been considered. However, since applicant's conclusion that the hinged lid of Whittaker is a constituent part of the lighter is not found convincing, the rejection is considered to have been properly made.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this or earlier communications from the examiner should be directed to Sara Clarke whose phone number is 571-272-4873. The examiner normally can be reached Mon-Fri, 8:30-1:00.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Ira Lazarus, can be reached at 571-272-4877. The fax number for the organization where this application is assigned is 703-872-9306.

Status information for an application is available from the Patent Application Information Retrieval (PAIR) system. Status information for published applications is available from Private or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about PAIR, see <http://pair-direct.uspto.gov>. For questions on access to Private PAIR, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sara Clarke 
Primary Examiner
Art Unit 3749

December 21, 2004